



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Bachand, et al.

Serial No. : 09/150,692

Group Art Unit: 1761

Filed : September 10, 1998

Examiner: D. Becker

Title : LABELLESS, ROLLED FOOD ITEM
AND ITS FABRICATION

Docket No. 5137 (9649/105)

Commissioner for Patents and Trademarks
Washington, D.C. 20231

SUPPLEMENTAL APPELLANT'S BRIEF

Dear Sir:

In response to the Office communication mailed August 22, 2001, appellant wishes to appeal the new rejections of Examiner Becker. In particular, claims 1-10 have been rejected based upon newly cited art, namely Pulici [Patent No. 3,669,007].

(6) AMENDED ISSUES

Are claims 1-4 unpatentable under 35 U.S.C. § 103(a) as being obvious over WO97/33822 in view of Patent No. 3,669,007? Are claims 5-10 unpatentable under 35 U.S.C. § 103(a) as being obvious over WO97/33822 in view of Patent No. 3,669,007 and Assignee's prior Patent No. 5,853,836?

ARGUMENT

Pulici discloses:

Since many of the foodstuffs use envelopes or wraps of a flour paste, the bonding medium liquid may be water. [emphasis added, column 2, lines 2 and 3]

* * *

In the case of burritos, a binder liquid, such as water, is applied to the outer roll layer 29 of the rolled food product and margin 27 is then compressed downwardly upon the outer roll such that the rolled configuration is preserved by the adhesion of

RECEIVED
MAR - 7 2002
TC 1700

one layer to the other. [emphasis added, column 2, lines 65-69]

* * *

The terminal margin of the wrap may be sprayed from a binder supply 157 in the last roll. If the wrap material dictates, the wrap may be sprayed alternatively from a forward supply 158 ahead of the side plows to allow the spray to penetrate the wrap to make it tacky when rolling is completed. [column 5, lines 62-66]

* * *

. . . applying a water spray to the wrap adjacent the exposed margin thereof, . . . [emphasis added, lines 2 and 3 of claim 7]

It is respectfully submitted that Pulici is cumulative to the previously cited and applied Shapiro [U.S. Patent No. 5,514,397]. Shapiro teaches adherence of sheets and/or strips of dough together. It should be appreciated that the express teachings of Shapiro are limited to doughs which require further cooking either by the manufacturer or the consumer. Furthermore, the use of water is taught since the doughs "include a grain flour already" (column 6, line 2 of Shapiro). Both Pulici and Shapiro teach use of water as a binder for flour based doughs, and neither provide teachings that water could be used as a binder for foodstuffs formed without flour.

The claims of this application were originally rejected by Examiner Becker in an official communication mailed August 25, 1999 based upon Zoss and Shapiro. Examiner Becker apparently recognized the patentability of the present invention over the teachings of water as a binder for dough including "a grain flour already" because Shapiro was not applied in the Office communications mailed April 24 or September 12, 2000. It is then respectfully submitted that the present invention is patentable over Pulici for the same and similar reasons as previously recognized for Shapiro.

Specifically, it is respectfully submitted that Pulici and/or Shapiro do not face or solve the problems presented in the field of the present invention. It should be noted that in the most preferred form, food 14 is a sweetened dehydrated fruit-based material (claim 9). In

particular, food 14 has a moisture content that enhances its shelf life and particularly does not result in undesirably degrading during normal storage times before consumption (page 8, line 19 and following of the present application). In particular, if the moisture content was too high, food 14 may degrade such as by molding (page 11, lines 27-35 of the present application). It is believed that this is one of the reasons that corn syrup or similar adhesive was previously utilized in nonflour based foodstuffs, as the adhesion was based upon the qualities of the corn syrup and not the food itself and the moisture content of the food was not significantly increased. Being directed to burritos, the foodstuffs of Pulici would be refrigerated and/or frozen where moisture content and molding are not of the same concern.

In particular, although Pulici and/or Shapiro disclose the use of a binding agent such as water between dough including flour, Pulici and/or Shapiro do not suggest that water can be utilized to increase the adherence of a food which does not include a grain flour or to increase adherence of a food (whether it includes grain flour or not) to a strip of support material. It is respectfully requested that the Examiner identify why a person skilled in the art would consider Pulici and/or Shapiro absent the hindsight teachings of the present invention. In particular, since Pulici and/or Shapiro do not provide any teachings relating to adhering food to a support material or to foodstuffs which do not include flour, why would a person skilled in the art even consider Pulici and/or Shapiro to be relevant to problems in the field of the present invention absent the hindsight knowledge of the present invention. As stated by the CCPA in *In re Van Wanderham, Worthley, and Comolli*, 154 USPQ 20, 24, 25 (1967):

Closely related to the doctrine of nonanalogous art is the doctrine forbidding hindsight reconstruction, also discussed in *Potts, supra*. In applying section 103, the Supreme Court recently cautioned against "slipping into hindsight." (case citations)

* * *

The opinion in *Sporck* further provides, 49 CCPA at 1043, 44, 45; 133 USPQ at 363, 364:

Once appellant's solution to the problem of making a tapered wall frusto-cone is disclosed, it is easy to see how the prior references can be modified and manipulated to produce this type of cone. The change admittedly is simple and by hindsight seems obvious. However, the simplicity of new inventions is oftentimes the very thing that is not obvious before they are made.

* * *

It is of course true that the examiner was able to locate the Sato article. However, it appears that this was done through reading into the art the teachings of appellants' invention. *In re Murray*. We think the Patent Office's conclusion of obviousness is based on an impermissible hindsight reconstruction of the art. *In re Sprock*.

Our determination here is not without difficulty. However, we think the difficulty arises from not considering the subject matter as a whole and instead of focusing on the scientific principle involved . . .

Likewise, the CCPA stated in *In re Shapleigh*, 115 USPQ 129, 133 (1957):

The test as to whether two references are from non-analogous arts is whether one seeking to solve a problem with respect to the embodiment of a reference in one art would be apt to seek the solution to said problem in the other art. (case citation)

Similarly, the CCPA in *In re Antle*, 170 USPA 285, 287-288 (1971) stated:

In Winslow we said that the principal secondary reference was "in the very same art" as appellant's invention and characterized all the references as "very pertinent art." The language relied on by the solicitor, quoted above, therefore, does not apply in cases where the very point in issue is whether one of ordinary skill in the art would have *selected*, without the advantage of hindsight and knowledge of the applicant's disclosure, the particular references which the examiner applied. As we also said in Winslow, "Section 103 requires us to presume full knowledge by the inventor of the *prior art in the field of his endeavor*" . . . but it does not require us to presume full knowledge by the inventor of prior art *outside* the field of his endeavor, i.e., of "non-analogous" art. In that respect, it only requires us to presume that the inventor would have that ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be

expected of a man of ordinary skill in the art to which the subject matter pertains. (emphasis theirs)

In determining what is analogous art, the Court of Appeals for the Federal Circuit stated in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 USPQ 584 (1984):

In resolving the question of obviousness under 35 U.S.C., § 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combination of teachings from references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

Furthermore, even if the references relied upon by the Examiner were known for some reason, it should be appreciated that the reasons provided by the Examiner to show that the alleged modifications to Zoss and/or WO/973382 are based upon the hindsight knowledge of the present invention for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd., v. Union Oil Co. of Cal.*, 218 USPQ 865, 870 (1983) stated:

All the pieces of the present invention were known in the art, . . . That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. (Case citations.)

Further, the CAFC in *In re Gordon*, 221 USPQ 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Similarly, the Court of Appeals for the Federal Circuit in *In re Sernaker*, 702 F.2d 989, 217 USPQ 1, 5 (1983) stated:

We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art, that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

Likewise, as stated by the CCPA in *In re Kamm and Young*, 172 USPQ 298 at 301 and 302:

The rejection here runs afoul of a basis mandate inherent in Section 103--that "a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure" shall not be the basis for a holding of obviousness. In *re Rothermel*, 47 CCPA 866, 870, 26 F.2d 393, 396, 125 USPQ 328, 331 (1960). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In *re Wesslau*, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965). We think this has been done here.

We appreciate the relative ease with which one can slip into such an error, especially where, as here, the primary reference addresses the same problem as appellants and solves it using merely a different chemical agent. However, we are satisfied that when the secondary references are viewed in their entirety, with due consideration given to what they fail to disclose and what they disclose as undesirable, it is evident that the proposed modification of the primary reference would not have been obvious to one of ordinary skill in the art at the time the invention was made.

Turning to the present application, Zoss discloses the use of a label and the use of edible adhesive such as corn syrup also disclosed in WO97/33822. There is no disclosure of any suggestions of any other modifications or the desirability of such modifications in Zoss and/or WO97/33822. Additionally, food 14 of Zoss is disclosed as being a sweetened dehydrated fruit-based material, and the food of WO97/33822 is disclosed as being gum or candy. As there is no disclosure that the food of Zoss and/or WO97/33822 includes a grain flour, a person skilled in the art considering Shapiro and/or Pulici would not be suggested to utilize water but would be taught to use an "edible paste" which would be consistent with the teachings of Zoss and WO97/33822. There is no disclosure of utilizing water for non-grain flour based material in Pulici, Shapiro, Zoss, or WO97/33822. Only the present invention provides the hindsight teachings necessary to select just the right elements and combine them in just the right way to arrive at the recitations of the claims. It is then respectfully submitted that the rejection of claim 1 and the claims which depend therefrom has been overcome. Favorable reconsideration is respectfully requested.

Similarly, as Pulici discloses the use of water for adhering dough together, it is respectfully submitted that Pulici provides no suggestion as to the use of water to adhere food to a strip of support material as recited in claim 1 and in particular to silicon parchment paper as recited in claim 10. It is then respectfully submitted that the rejection of claims 1 and 10 has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

Assuming that a person skilled in the art considered Pulici as being pertinent to the problem faced by the food item of Zoss and/or WO97/33822, Pulici would teach spraying the outer roll layer or to spray the entire food item before rolling as there is no teaching in Pulici that water would be sprayed adjacent to the trailing edge. Thus, it is respectfully submitted

that the rejection of claims 1, 2 and 3 and the claims which depend therefrom has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

Similarly, claim 6 further recites that the deposit is spaced inwardly from the side edges of the food. Clearly, a person skilled in the art would not be suggested by Zoss, WO97/33822, Pulici and/or Shapiro to arrive at the recitations of claim 6. Thus, it is respectfully submitted that the rejection of claim 6 and the claims which depend therefrom has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

As Pulici discloses the use of water for "grain flour" doughs, it is respectfully submitted that Pulici provides no suggestion as to the use of water for sweetened dehydrated fruit-based material as recited in claim 9. It is then respectfully submitted that the rejection of claim 9 has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

CONCLUSION

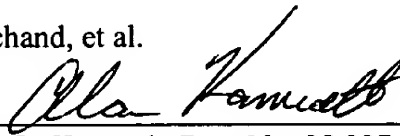
By rejecting claims 1-10 under a new ground of rejection, Examiner Becker apparently concedes that the rejection of these claims in the September 12, 2000 official communication from which this appeal was taken has been overcome. Additionally, Examiner Becker has also apparently conceded that a rejection based upon the use of water as a binder in flour based foodstuffs has been overcome since the prior rejection based upon the Shapiro reference was withdrawn. Therefore, a rejection based upon Pulici, which does not provide any teachings beyond Shapiro, should be withdrawn for the same reasons as already recognized by Examiner Becker for Shapiro.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicants' labelless, rolled food item and its fabrication which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken singly or in any combination, the Board of Appeals is requested to reverse the new rejection of the Examiner, to allow claims 1-10 and 14-20 of the present application, and to pass this application to issue.

Respectfully submitted,

Bachand, et al.

By



Alan D. Kamrath, Reg. No. 28,227
Rider, Bennett, Egan & Arundel, LLP
333 South Seventh Street
Suite 2000
Minneapolis, Minnesota 55402
(612) 340-8925
(612) 340-7900 facsimile

DATED: February 22, 2002